REMARKS

In the Office Action of October 12, 2006, claims 23, 25, 27, and 31-32 were rejected under 35 U.S.C. §103(a) as being unpatentable over Snell U.S. Patent Appl. Publication No. 2005/0155328 ("*Snell*") in view of Bercaits U.S. Patent 6,370,843 ("*Bercaits*"). Claim 26 also was rejected under §103(a) as being unpatentable over *Snell* in view of *Bercaits*, and in further view of Yamamoto U.S. Patent No. 3,643,308 ("*Yamamoto*"); and claims 28-29 were rejected under §103(a) as being unpatentable over *Snell* in view of *Bercaits*, and in further view of Esteves U.S. Patent No. 5,590,509 ("*Esteves*"). Additionally, claim 29 was rejected under 35 U.S.C. §112, ¶2 as being indefinite.

After amendments herein, claims 23, 25-29, 31, and 32 remain pending for examination. Applicant respectfully requests further consideration of these pending claims in view of the following remarks.

First, with regard to the rejections under §112, ¶2, Applicant submits that the language of this claim is definite and that it is unnecessary to specify whether the separate flat panels of material are fed from two different sources. Indeed, Applicant sees no reason why the claim should be limited to either the situation in which the separate flat panels of material are fed from the same source or the situation in which the separate flat panels of material are fed from two different sources. Because the claim is properly generic in coverage, Applicant respectfully requests withdrawal of this rejection of claim 29.

Second, with regard to the rejections of the claims based on the combination of *Snell* and *Bercaits*, Applicant submits that the asserted combination is improper and that, therefore, the stated §103(a) rejections of all claims should be withdrawn. Specifically, *Bercaits* is nonanalogous art with respect to the recited method of the present claims and, therefore, *Bercaits* is inapplicable in a §103(a) rejection of any of the claims.

A reference must be analogous art in order to support a rejection under 35 U.S.C. § 103, *see* State Contracting & Eng' g Corp. v. Condotte America, Inc., 346 F.3d 1057, 1068, 68 USPQ2d 1481, 1488 (Fed. Cir. 2003) (emphasizing question of analogous art irrelevant to §102 inquiry but relevant to §103 inquiry). In order for a reference to be analogous art, the reference must either be in the field of applicant's endeavor or, if not, then the reference must be reasonably pertinent to the particular problem with which the inventor of the invention was

concerned. In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). A reference is "reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992).

In the present case, Applicant submits that *Bercaits* is neither in the field of endeavor of *Klippen et al.*—the inventors of the present applications, nor does *Bercaits* share commonality in the problem identified and addressed by *Klippen et al.* so as to be "reasonably pertinent to the particular problem with which [*Klippen et al.*] was concerned." The relevant field of endeavor in the present application is the packaging of a diaper for convenient carrying and use by consumers. In stark contrast, the field of endeavor of *Bercaits* relates to the clothing industry and comprises the packaging for transport of pieces cut from a lay-up built up from plies of superposed flexible sheets of a material, especially woven cloth, wherein the lay-up is packaged in full inside a covering without separating the cutout pieces from the scrap. There is simply no overlap or similarity in these different fields of endeavor.

In the present case, Applicant additionally submits that *Bercaits* simply would not have commended itself to one having ordinary skill in the art of diaper and their manufacture and packaging when faced with the problem of *Klippen et al.*. Because *Bercaits* discloses and deals with pieces cut from lay-ups and their shipping, Applicant submits that one having ordinary skill in the art of manufacture and packaging of diaper kits simply would not have looked to *Klippen et al.* as an obvious choice for consideration in attempting to develop a more convenient diaper package for carrying and use by consumers. Furthermore, Applicant acknowledges that a solution presented by *Bercaits* and a solution presented by *Klippen et al.* do exhibit a commonality, namely, the utilization of a vacuum. However, Applicant emphasizes that the proper inquiry as to whether *Bercaits* would have commended itself to the ordinary artisan's attention in considering the problem of *Klippen et al.* focuses on the commonality in the identified problems, and not in any commonality in the identified solutions.

In fact, looking to the commonality in the solution in this type of inquiry represents impermissible hindsight that must be guarded against. Monarch Knitting Machinery Corp. v. Fukuhara Industrial & Trading Co., Ltd., 139 F.3d 877, 45 USPQ2d 1977 (Fed. Cir. 1998) ("Defining the problem in terms of its solution reveals improper hindsight in the selection of the

prior art relevant to obviousness.") (citing In re Antle, 58 CCPA 1382, 444 F.2d 1168, 1171-72, 170 USPQ 285, 287-288 (CCPA 1971) (warning against selection of prior art with hindsight)).

Finally, Applicant notes that the Examiner has presented no evidence as to the applicability of *Bercaits* and, therefore, Applicant submits that the §103(a) rejection set forth in the Office Action is critically deficient on its face, and that the Office Action thus fails to make a *prima facie* showing of obviousness. The Office Action asserts neither commonality in the fields of endeavor of *Klippen* and *Bercaits*, nor commonality in the problems addressed by *Klippen* and *Bercaits*. Because of this deficiency in the §103(a) rejection, Applicant submits that the §103(a) rejection cannot stand and that the §103(a) rejection must be withdrawn.

In view of the foregoing, Applicant respectfully requests withdrawal of the rejections of the claims and the passing of the present application to issue. Applicant additionally respectfully requests that the Examiner contact the undersigned if any further action is deemed necessary by the Examiner in order to gain allowance of the present application, and if such further action may be accomplished through an Examiner's amendment or otherwise.

Respectfully submitted,
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